

Response to Office Action Mailed November 6, 2003

A. Pending Claims

Claims 1-11, 13-18 and 20-22 have been rejected. Claims 1, 9, and 16 have been amended. Claims 1-11, 13-18, and 20-22 are pending.

B. The Claims Are Not Obvious Over Borghesi In View of Burchetta Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 6, 7, 9, 10, 12-14, 16, 17, and 19-21 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,950,169 to Borghesi et al. (hereinafter "Borghesi") in view of U.S. Patent No. 6,330,551 to Burchetta et al. (hereinafter "Burchetta"). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. Applicant submits that the cited art, taken in combination, does not appear to teach or suggest all of the claimed limitations of the cited art.

Amended claim 1 describes a combination of features including:

an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to:

estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the

sequence of execution of the insurance claims processing steps are established dynamically in real time

Support for the amendments to claim 1 can be found, for example, in Applicant's specification, which states:

In one embodiment, during the processing of an insurance claim, a business rule and/or an IC system user input may determine that the insurance claim processing needs the execution of additional steps or tasks to continue the processing of the claim. The IC system user may provide inputs to the insurance claims processing server software 60 at any display screen associated with a step included in a Table of Contents. The insurance claim processing software may dynamically modify the number of steps and/or the sequence of their execution to complete the claim processing transaction. An IC system user working at a client system 20b may then iterate through the claim processing steps and arrive at an estimated value for the insurance claim.

(Specification, page 13, lines 21-29)

Amended claim 1 includes, but is not limited to the feature of:

“estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time; wherein the first set of program instructions further comprise a sequence of insurance claim processing steps established dynamically in real time.

Applicant respectfully submits that Borghesi does not appear to disclose the combination of features in Applicant's claims, including, but not limited to the establishment of program instructions dynamically. The Examiner appears to attempt to remedy the deficiencies of Borghesi with Burchetta by stating that “it would have been obvious to one of ordinary skill in the art to include the dynamic features of Burchetta within the system of Borghesi.”

Amended claim 1 is directed to a sequence of insurance claim processing steps that are established dynamically in real time. Applicant submits that none of the cited portions of

Burchetta describe at least the feature of “a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.”

Furthermore, Applicant respectfully disagrees with Examiner’s assertion that Burchetta teaches the combination of features in Applicant’s claims, including, but not limited to the establishment of a sequence of steps dynamically. The Examiner states that:

Burchetta includes a real time system for the entry of claims and settlement offers, wherein the computer program provides for logging into the system to edit or view cases/claims by entering a username and corresponding password, wherein if the username and password do not match those known in the system, the user is shown an error screen with the option to try again, wherein if the user has logged in before with the same computer, his or her user name may already be entered into the system, and the server which distributes the web pages checks the user’s password against a username.

The Examiner states that the cited portions of Burchetta “reads on ‘wherein the first set of program instructions comprise a sequence of steps established dynamically in real time’...” Applicant respectfully disagrees. Burchetta appears to teach a method of verifying a login ID. The steps of verifying a login ID are not established dynamically, but instead are pre-set by the programmers of the software. No matter how the login process is implemented, (e.g., with or without the use of cookies) the program of Burchetta appears to teach performing a verification step. There does not appear to be any teaching or suggestion that a verification of a login step is, or could be, optional or would be dynamically created. The fact that a computer program includes branches that are invoked based on the inputted answer of a user of the program does not teach that the program is dynamically creating processing steps. As such, Applicant submits that these cited portions of Burchetta do not appear to teach or suggest the dynamic establishment of processing steps.

Finally, the Examiner states that:

Burchetta includes upon logging into the system, for the user add or edit a claim, wherein the add/edit screen includes a "submit" button, which send the information entered on the website to be checked for formatting, wherein the screen points out missing or improperly formatted text, or returns text for verification, and wherein if the text is accepted, the data is sent to the database for entry as an addition or update.

The Examiner state that the cited portions of Burchetta "reads on 'wherein the first set of program instructions comprise a sequence of steps established dynamically in real time'"

Applicant respectfully disagrees. Burchetta appears to teach a method of verifying data that is entered. The steps of verifying data are not established dynamically, but instead are pre-set by the programmers of the software. Regardless of how the data entry is performed, the program of Burchetta appears to teach performing a verification step. There does not appear to be any teaching or suggestion that a verification of data entry is, or could be, optional or would be dynamically created. The fact that a computer program includes branches that are invoked based on the answer of a user of the program does not teach that the program is dynamically creating processing steps. As such, Applicant submits that these cited portions of Burchetta do not appear to teach or suggest at the dynamic establishment of the "number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps." As such, Applicant respectfully requests the removal of the Examiner's rejections of claim 1 and the claims dependent from claim 1.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant submits that, for at least the reasons cited above, that the claims dependent from claim 1 are patentable over the cited art.

Amended claim 9 describes a combination of features including:

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

Applicant submits, for at least the reasons cited above, that the features of claim 9 are not taught or suggested by Borghesi in view of Burchetta. Applicant respectfully requests removal of the rejection of claim 9 and the claims dependent thereon.

Amended claim 16 describes a combination of features including:

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

Applicant submits, for at least the reasons cited above, that the features of claim 16 are not taught or suggested by Borghesi in view of Burchetta. Applicant respectfully requests removal of the rejection of claim 16 and the claims dependent thereon.

Applicant further submits that many of the dependent claims are independently patentable over the combination of Borghesi and Burchetta.

For example, neither Borghesi nor Burchetta appear to disclose, teach, or suggest “wherein the insurance claim comprises a bodily injury claim, and wherein the estimate of the value of the insurance claim comprises an estimate of bodily injury general damages” as recited in claim 2. While the Examiner has cited several passages in Borghesi regarding “data gathered concerning the extent of damage or injury suffered by the insured (Borghesi, col. 22, line 57-58),” the Examiner has failed to point out any teachings in Borghesi or Burchetta which teach “an estimate of bodily injury general damages” as recited in claim 2. Applicant asserts claim 2 is also allowable for at least the above reason.

In addition, neither Borghesi nor Burchetta appear to disclose, teach, or suggest “one or more treatments of the bodily injuries” as recited in claim 8. The Examiner submits that “Borghesi fails to expressly disclose the one or more treatments of bodily injuries (Office Action, page 7).” However, Applicant respectfully disagrees that a “skilled artisan would have found it an obvious modification to include treatments of bodily injury within the system taught collectively by Borghesi and Burchetta (Office Action, page 7)” as stated by the Examiner. Borghesi appears directed towards automotive claims and does not appear to disclose any framework for dealing with the additional complications that arise when dealing with insurance claims for bodily injuries. Applicant asserts a person of ordinary skill in the art, at the time of the invention, would not have combined “treatments” with Borghesi without the benefit of the Applicant’s disclosure. Applicant asserts claim 8 is also allowable for at least the above reason.

As the Examiner is certainly aware, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination. The alleged suggestion that the combination would be made because it would enhance the useability of the system is not a suggestion at all; otherwise, the more “enhanced” a system improvement, the more obvious the system becomes, i.e., the greater the invention, the more obvious it becomes. Of course, such a standard would be unworkable to support a 103 rejection.

C. The Claims Are Not Obvious Over Borghesi In View of Burchetta In Further View of McKee Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 3 and 4 under 35 U.S.C. 103(a) as obvious over Borghesi

in view of Burchetta in further view of U.S. Patent No. 6,272,482 to McKee et al. (hereinafter "McKee"). Applicant respectfully disagrees with these rejections.

Again, the Applicant respectfully notes that the Examiner appears to have used hindsight, based on having the benefit of the Applicant's disclosure, to find references to reject the Applicant's claims. Applicant respectfully submits that it would not have been obvious to a person of ordinary skill in the art to combine Borghesi, Burchetta, and McKee.

Furthermore, Borghesi, Burchetta, and McKee do not, either separately or in combination, appear to disclose, teach, or suggest "wherein the first set of program instructions are further executable by the first CPU to generate and send to the client computer system a plurality of web pages comprising insurance claim assessment questions" as recited in claim 4. While the Examiner has cited several sections of Burchetta for this teaching, Applicant respectfully notes that none of the cited sections appears to teach "a plurality of web pages comprising insurance claim assessment questions" as recited in claim 4. Burchetta seems to teach using the Internet, but does not appear to teach insurance claim assessment questions on the web pages. Applicant asserts claims 3 and 4 are also allowable for at least the above reasons.

E. Summary

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

Applicant respectfully requests a one-month extension of time to respond to the Office Action dated November 6, 2003. A fee authorization form in the amount of \$420.00 is enclosed for the extension of time fee. If any further extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-36000/EBM.

Respectfully submitted,



Mark R. DeLuca
Reg. No. 44,649

Patent Agent for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

Date: 3/24/04